

REMARKS

This Amendment, submitted in reply to the Office Action dated June 7, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-30 are all the claims pending in the application.

I. Rejection of claims 2, 5, 9, 13, 18, 21 and 25-30 under 35 U.S.C. § 112

Claims 2, 5, 10¹, 13, 18, 21 and 25-30 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejects claims 1, 5, 10, 13, 18 and 21 stating that the limitation “the content entity” in the step of receiving a user-provided location lacks sufficient antecedent basis. Claims 1, 5, 10, 13, 18 and 21 have been amended as indicated above. Consequently, Applicant respectfully submits that the claims 1, 5, 10, 13, 18 and 21 are now in proper form and the rejection of claims 1, 5, 10, 13, 18 and 21 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

The Examiner rejects claims 25-30 stating that there is insufficient antecedent basis for the limitation “the plurality of content entities.” Claims 25, 26, 27, 28, 29 and 30 depend on

¹ Pursuant to a telephonic discussion between Examiner Pham and the below-identified Applicant's representative, the Examiner indicated that claim 10 instead of claim 9, as indicated in the Office Action, should have been rejected under 35 U.S.C. § 112, second paragraph.

claims 1, 4, 9, 12, 17 and 20 respectively. The first few lines of each of claims 1, 4, 9, 12, 17 and 20 recite the language “the plurality of content entities.” Consequently, Applicant respectfully submits that claims 25-30 have sufficient antecedent basis and the rejection of claims 25-30 should be withdrawn.

II. Rejection of claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 under 35

U.S.C. § 103

Claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over The McGraw-Hill Companies (hereinafter McGraw) [Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>].

Applicant respectfully submits the following in traversal of the rejection, assuming, only for the purposes of argument, that the McGraw reference qualifies as prior art under § 102.

Claims 1, 9 and 17

Claim 1, for example, recites a method for adding user-provided content to a content object stored as a plurality of content entities in a data repository. The Examiner urges that in McGraw, an e-book is a content object that is defined by a list of chapters and sections as content entity identifiers. The Examiner also states that an e-book is built by receiving the content of corresponding chapters and section as user-provided content when the user clicks the add button with the assigned chapter name or section name as an identifier.

However, it is respectfully submitted that the e-book (Corley, et al.: The Legal and Regulatory Environment of Business, 11th Edition, hereinafter “Corley”) to which the Examiner refers in the McGraw reference is an e-book that already exists in the McGraw system at the time a user clicks the “Add” button on the screen shown at the top of page 5 of the Office Action. It is respectfully submitted that McGraw neither teaches nor suggests that the “Add” features adds an identifier of user-provided content, as required by claim 1. Rather, the selection of a chapter or section by clicking the “Add” button in McGraw appears only to add to an e-book content already existing in the McGraw system. There is no teaching or suggestion that it would result in the addition of the chapter or selection to Corley, since the respective chapter or section currently exists in the e-book Corley.

Accordingly, it is respectfully submitted that claims 1, 9 and 17 and their dependent claims are not rendered unpatentable by McGraw. Since claims 4, 12 and 20 recite similar elements, claims 4, 12 and 20 and their dependent claims should be deemed patentable for the same reasons.

III. Rejection of claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 under 35 U.S.C.

§ 103

Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McGraw in view of Rowe (U.S. Patent No. 6,073,148).

Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 should be deemed patentable by virtue of their dependency to independent claims 1, 4, 9, 12, 17 and 20 for the reasons set forth above.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/488,976

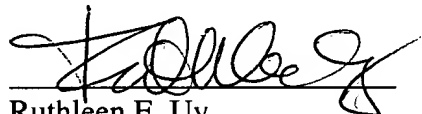
Attorney Docket No.: A8486

Moreover, Rowe does not cure the deficiencies of McGraw nor is the combination of Rowe with McGraw obvious.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Ruthleen E. Uy
Registration No. 51,361

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 7, 2004